



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY, DOCKET NO.	CONFIRMATION NO.
09/843,838	04/30/2001	Hideyuki Ijiri	50212-227	1916

7590 02/15/2005

McDERMOTT, WII & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

HOFFMANN, JOHN M

ART UNIT PAPER NUMBER

1731

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,838

Applicant(s)

IJIRI ET AL.

Examiner

John Hoffmann

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-5, 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 5 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-5, 9, 11, 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroo JP 62-167235 in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491.

See how the art was previously applied. Claim 16 has been amended so that the preamble now further defines the type of optical fiber the preform is for.

First it is deemed that this limitation does not breathe life and meaning into the claim, because the claim does not require a step of creating any fiber.

Second (if examiner erred and the limitation does breathe life and meaning to the claim), the claim does not specify in what way the preform is "for" the fiber. As an absurd case: the preform could be used essentially as a paperweight (i.e. a fiber weight) "for" any fiber. But for a more relevant case, a preform could be used as an preliminary preform – one could etch, machine, add additional cladding layers, etc. to form the final preform. More specifically, in as much as applicant argues that the Hiroo fiber does not have a managed dispersion, the Hiroo fiber is "for" the fiber of the preamble because they are both needed "for" each other to be useful. (A compensating fiber is

Art Unit: 1731

substantially useless if there isn't an un-compensated fiber that requires a compensating fiber.)

Third and most importantly, as can be seen in Onishi 6502428, the dispersion properties of a fiber, depend upon the way in which it is drawn. Note figure 1 and the associated discussion of Onishi which shows that a uniform preform (col. 3, lines 28-47) can be drawn to have both a negative and a positive chromatic dispersion. Thus, the preamble limitation of the intention to draw a particular type of fiber fails to define over the Hiroo preform – which could be used to make either sort of fiber. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroo JP 62-167235 in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491 and further in view of Berkey 5894537 in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491.

Art Unit: 1731

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroo (or the Hiroo abstract) in view of any of Kortan 5560759, Oleskevich 5790735 and DiGiovanni 5966491 as applied to claim 1 and further in view of Kyoto 5221309.

See the prior Office actions for the manner in which the art is applied.

Response to Arguments

Applicant's arguments filed 27 Jan 2005 have been fully considered but they are not persuasive.

It is argued that the Hiroo preform is a material for obtaining a single-mode fiber or a dispersion-shifted fiber. Applicant has given no argument or evidence as to why the Hiroo preform could not be used "for" a dispersion compensating fiber. As indicated in the rejection above, the intended use limitation of the claim does not define over the prior art. As evidenced by the Onishi reference, the properties of the final fiber depend upon the draw process.

It is argued that the Office's comparison of diameter ratios is improper because it compares preform ratios to fiber drawn ratios. This is not convincing because the ratios would be the same. For example if a fiber is stretched to 4 times its length, the core diameter would be half of its original, and the cladding diameter would be half its original, but the ratio of the two would be the same.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

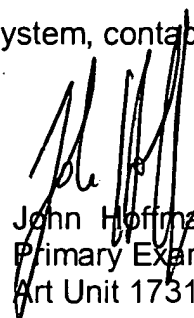
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

2-14-05

jmh